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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,427	01/27/2004	Robert LaFave	POL-00011	1525

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EXAMINER	
ZACHARIA, RAMSEY E	
ART UNIT	**PAPER NUMBER**
1773	

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/765,427	LAFAVE ET AL.	
	Examiner	Art Unit	
	Ramsey Zacharia	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-148* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-148* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 November 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/03/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

2. Some of the references in the IDS filed 03 November 2004 have been lined through for failing to meet all the requirements of 37 CFR 1.98. In particular, see 37 CFR 1.98(b)(5) requiring that each publication listed must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

Drawings

3. The drawings were received on 03 November 2005. These drawings are acceptable.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 124 and 138-148 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. This is a new matter rejection. No support could be found in the disclosure as originally filed for a polymeric substrate comprising a material selected from the group consisting of a thermoplastic polyolefin, ABS, and combinations thereof.

Claim Rejections - 35 USC § 102

6. Claims 1, 3-15, 17-28, 30-40, 42-61, 63-74, 76-86, 94, 96-110, 112-123, 125, and 127-137 are rejected under 35 U.S.C. 102(b) as being anticipated by Grimes et al. (U.S. Patent 4,330,352).

Grimes et al. teach a laminate comprising a substrate **1**, decorative metalized layer **2**, an adhesive layer **3**, carrier layer **4**, and a release layer **5** (Figure 2 and column 2, lines 29-51). The laminate is used to apply decorations to a substrate such as a motor vehicle (column 1, lines 13-15). Because motor vehicles have curved surfaces, the application of the laminate to a motor vehicle encompasses application onto a curved surface. Substrate **1** corresponds to the polymeric substrate of the instant claims. Decorative metalized layer **2** corresponds to the paint or color containing film system of the instant claims. Adhesive layer **2** corresponds to the adhesive film of the instant claims. Carrier layer **4** corresponds to the support film of the instant claims. Release layer **5** corresponds to the release layer of the instant claims. The carrier layer may be stripped off the laminate, i.e. it is releasably adhered (column 2, lines 49-51). The carrier layer may be formed of polyvinyl fluoride and has a thickness of about 0.5 to 5 mils, i.e. about 0.0005 to 0.005 inches (column 2, lines 52-62).

Grimes et al. are silent with respect to the tensile strength of the carrier layer at 300 °F. However, because Grimes et al. uses the same material (polyvinyl fluoride) within the same

thickness range (about 0.0005-0.005 in) as the support film of the instant invention (see paragraphs 00237 and 00238 on page 41 of the instant specification), the carrier of Grimes et al. should inherently possess the same tensile strength as the support film of the instant invention.

Regarding claims 6, 9, 19-22, 28-39, 45, 48, 55, 57, 67, 78, 81, 84, 101, and 104-109, the release layer of Grimes et al. reads on a release layer that is operable to be peeled away from the polymeric substrate, paint or color containing film, etc. because that claims merely require the release layer to be "operable to peeled away." Since the release layer of Grimes et al. is not irreversibly adhered to the laminate but may be cut away and peeled back, the release layer meets the language of the claims.

Claim Rejections - 35 USC § 103

7. Claims 1, 3-15, 17-28, 30-40, 42-61, 63-74, 76-87, 89-94, 96-110, 112-123, 125, and 127-137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes et al. (U.S. Patent 4,330,352) in view of Johnson et al. (U.S. Patent 5,518,786).

Grimes et al. teach a laminate comprising a substrate **1**, decorative metallized layer **2**, an adhesive layer **3**, carrier layer **4**, and a protective layer **5** (Figure 2 and column 2, lines 29-51). The laminate is used to apply decorations to a substrate such as a motor vehicle (column 1, lines 13-15). Because motor vehicles have curved surfaces, the application of the laminate to a motor vehicle encompasses application onto a curved surface. Substrate **1** corresponds to the polymeric substrate of the instant claims. Decorative metallized layer **2** corresponds to the paint or color containing film system of the instant claims. Adhesive layer **2** corresponds to the adhesive film of the instant claims. Carrier layer **4** corresponds to the support film of the instant claims.

Protective layer **5** corresponds to the surfacing film system of the instant claims. The carrier layer may be stripped off the laminate, i.e. it is releasably adhered (column 2, lines 49-51). The carrier layer may be formed of polyvinyl fluoride and has a thickness of about 0.5 to 5 mils, i.e. about 0.0005 to 0.005 inches (column 2, lines 52-62).

Grimes et al. are silent with respect to the tensile strength of the carrier layer at 300 °F. However, because Grimes et al. uses the same material (polyvinyl fluoride) within the same thickness range (about 0.0005-0.005 in) as the support film of the instant invention (see paragraphs 00237 and 00238 on page 41 of the instant specification), the carrier of Grimes et al. should inherently possess the same tensile strength as the support film of the instant invention.

Grimes et al. do not teach use of a release layer that remains with the carrier layer when the carrier layer is stripped from the laminate.

Johnson et al. is directed to a dry transfer laminate used to decorate car body members or panels (column 1, lines 11-17). Johnson et al. teach that the carrier sheet may have a silicone coated release surface or a thin film of wax (column 5, line 46-column 6, line 18).

One skilled in the art would be motivated to coat the carrier layer of Grimes et al. with a silicone or wax release coating to facilitate the removal of the carrier layer, particularly when layer **5** is a protective layer.

8. Claims 124 and 138-148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes et al. (U.S. Patent 4,330,352) in view of Kobayashi et al. (U.S. Patent 6,045,744).

Grimes et al. teach all the limitations of claims 124 and 138-148, as outlined above, except for the use of a thermoplastic polyolefin, ABS, or combinations thereof as the material of

film **1**. However, Grimes et al. do teach that film 1 may be a vinyl chloride polymer, a polyester, or the like that are known in the art to be used in forming decorative laminates (column 2, lines 21-28).

Kobayashi et al. disclose a decorative laminate comprising a substrate and a decorative layer formed on the substrate (column 4, lines 50-57). The substrate may be formed of a polyvinyl chloride resin, a polyester, an ABS resin, polypropylene, or polyethylene (column 4, lines 58-65).

Kobayashi et al. demonstrate that polyvinyl chloride, polyester, ABS resin, polypropylene, and polyethylene are known in the art as functionally equivalent material for forming substrate layers upon which decorative layers are formed in decorative laminates. Therefore, because these polymers were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute an ABS resin, polypropylene, or polyethylene for the vinyl chloride polymer or polyester of Grimes et al.

9. Claims 2, 16, 29, 41, 62, 75, 95, 111, and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes et al. (U.S. Patent 4,330,352) in view of Spain et al. (U.S. Patent 5,725,712).

Grimes et al. teach all the limitations of claims 2, 16, 29, 41, 62, 75, 95, 111, and 126, as outlined above, except for the presence of a second removable film. However, Grimes et al. do teach a metallized laminate (**10**) having a removable carrier film (**4**) and an adhesive layer (**3**) that is ultimately bonded to layer **1**.

Spain et al. demonstrate that it is known to employ a release backing over an adhesive layer in a decorative laminate (Figure 14 and column 38, lines 50-65). The resulting laminate would then be able to be stored and later used as needed.

One skilled in the art would be motivated to employ a release backing over the adhesive layer of the metallized laminate of Grimes et al. to yield a decorative laminate that did not have to be laminated immediately to layer **1** but could be stored and used as needed. Moreover, it would be obvious to use the material of carrier film **4** as the release backing (an embodiment of the carrier film is explicitly taught as being coated with a release coating) because it is *prima facie* obvious to select any known material based on its suitability for its intended use, and a carrier film coating with a release coating is suitable as a release backing. See MPEP 2144.07.

10. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes et al. (U.S. Patent 4,330,352) in view of Johnson et al. (U.S. Patent 5,518,786) as applied to claim 87 above, and further in view of Spain et al. (U.S. Patent 5,725,712).

Grimes et al. taken in view of Johnson et al. teach all the limitations of claim 88, as outlined above, except for the presence of a second removable film. However, Grimes et al. do teach a metallized laminate (**10**) having a removable carrier film (**4**) and an adhesive layer (**3**) that is ultimately bonded to layer **1**.

Spain et al. demonstrate that it is known to employ a release backing over an adhesive layer in a decorative laminate (Figure 14 and column 38, lines 50-65). The resulting laminate would then be able to be stored and later used as needed.

One skilled in the art would be motivated to employ a release backing over the adhesive layer of the metallized laminate of Grimes et al. to yield a decorative laminate that did not have to be laminated immediately to layer **1** but could be stored and used as needed. Moreover, it would be obvious to use the material of carrier film **4** as the release backing (an embodiment of the carrier film is explicitly taught as being coated with a release coating) because it is *prima facie* obvious to select any known material based on its suitability for its intended use, and a carrier film coating with a release coating is suitable as a release backing. See MPEP 2144.07.

Response to Arguments

11. Applicant's arguments filed 03 November 2006 have been fully considered but they are not persuasive.

The applicants argue that the carrier film 4 taught by Grimes et al. does not correspond to the support film of the instant application because it does not perform the same function thereof. The applicants note that the carrier film is removed prior to the laminate coming in contact with the intended substrate and that the carrier film is not involved with any thermoforming operations.

This is not persuasive for the following reasons. Carrier film 4 does read on the support film of the instant invention because it is releasably adhered to, and therefore supports, the decorative film of Grimes et al. including film 1. Moreover, whether or not the film of Grimes et al. is used in a thermoforming process is immaterial to the instant claims since the instant claims are drawn to an article. The thermoforming process referred to in claim 1 is merely an intended use of the support film and it has been held that a recitation with respect to the manner in which a

claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Because Grimes et al. teach a carrier film formed of the same material having the same thickness as the instant support film, the carrier film of Grimes et al. should also inherently be thermoformable.

The applicants argue that the limitation that the support film has a tensile strength greater than 0.5 pli at 300 °F is not taught or inherent in the disclosure of Grimes et al. However, because Grimes et al. teach the use a material (polyvinyl fluoride) disclosed as a preferred material in the instant specification having a thickness range that is complete within the preferred thickness range of the instant invention, a *prima facie* exists that the carrier of Grimes et al. inherently possess the same tensile strength as the support film of the instant invention.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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